

R E M A R K S:

The present application is before the Examiner for the resumption of ex parte prosecution after the termination of interference Nos. 100,397, 100,398 and 100,703.

Claims 5-16, 18 and 25 through 53 remain pending in the application. Claims 33, 39, 44 and 4 have been withdrawn from consideration by the Examiner and claims 54-57 were cancelled in accordance with 37 CFR 1.265.

Applicants have carefully reviewed the Office Action and have amended the claims in a manner which is believed to overcome all of the Examiner's rejections.

Claims 12, 13, 15, 24-32, 34-38 and 40-43 have been rejection under 35 USC 102(g) and 35 USC 103 over the count of Interference No. 100,703 and over the disclosure of the winning party in said interference.

Claims 5-10, 14, 18, 24-32, 34-38, 42, 43, 47 and 51 have been rejected under 35 USC 102(g) and 35 USC 103 over the count of interference No. 100,397 and over the disclosure of the winning party in said interference.

Applicants believe that the claims as now amended are free of these rejections.

Interference No. 100,703 involved a count wherein the substituent corresponding to the R_1 in the present compound was a C_1-C_4 alkyl. Applicants have excluded these species from generic claim 47; have cancelled any claims which recite these species and have deleted these species from listings of compounds of the present invention. It is felt that the claims now recite subject matter which is patentable to applicants and which is patentably distinct from the count of Interference No. 100,703.

Interference No. 100,397 involved a count to only one compound namely the compound wherein the R_1 of the present compounds is propylphenyl. During this interference broader claims were set up as the count but the interference was dissolved since it was found that there was no interference in fact as to the broader count. A claim which recited only the propylphenyl derivative was suggested as the interference count and as to this compound only did applicants lose in the interference. Matsumura, et al had support in their priority documents only for this compound and were granted priority only as to this compound.

Applicants' original disclosure and priority documents

support a broad genus which comprise a C₁-C₃₀ alkyl substituted with a phenyl. It is submitted that applicants have demonstrated that they possessed the generic concept of the C₁-C₃₀ alkyl substituted with a phenyl and that they possessed this concept prior to the earliest date accorded to Matsumura, et al. for the single species. In such a situation, it is believed that applicants are entitled to claims reciting the genus regardless of the fact that Matsumura, et al. were granted priority as to one compound within the genus.

Applicants request that the Examiner reconsider his position as to these rejections and withdraw them in view of the above amendments and remarks.

Claim 45 has been rejected under 35 USC 103 as being unpatentable over Saeki.

Applicants request reconsideration by the Examiner.

Saeki disclose that hydrolysis of compounds such as formula VIII of the reference leads to a pyridine derivative "or the likes". One skilled in the art seeking to prepare nojirimycin or desoxynojirimycin derivatives would, hence, not use the procedure taught by this reference. It is

submitted that applicants' process is clearly non-obvious from the disclosure of this reference. Pyridine production requires dehydration which means loss of hydroxyl groups. It is not possible to reintroduce the hydroxyl groups by hydrogenation. Furthermore, the reintroduction would have to be accomplished stereospecifically. Finally, the hydrogenation conditions recited in the present claim is totally insufficient to reduce a hetero aromatic system.

Withdrawal of this rejection is requested.

Claims 5-9, 18 24-32, 34-38,k 40-43, 45 and 47-49 have been rejected under 35 USC 112, first and second paragraphs.

The recitation of "phenyl-acylcarbonyl" has been replaced by "phenyl ethylcarbonyl" which is supported on page 7, line 4 of the specification.

The Examiner asserts that the limitation regarding the heterocyclic carboxylic acid is vague and indefinite and lacks enablement for all it embraces. Applicants disagree with the Examiner. This claim terminology has specific literal basis in the specification at page 5, lines 5, 6 and 7. Specific exemplification of all possible species within this genus is not required by the Statute. If the Examiner

has any doubts as to why any such substituents would not be useful he must support his doubts by evidence. Absence such evidence or prior art, applicants are entitled to present this broad terminology.

The duplicated substituents in claims 48 and 49 have been deleted and the brackets in claims 47-49 have been replaced with parentheses.

As for the differing substituents on the phenyl and the phenyl and naphthyl moieties, applicants submit that the ordinary artisan would fully understand the intent of the claim language. R_1 can be inter alia phenyl or naphthyl. In addition, R_1 may be various substituents which can be substituted with a phenyl which in turn can carry substituents. It is applicants opinion that an ordinary artisan would understand the manner in which the various substituents could be substituted.

The entrance of the amendments to claims 24, 27 and 34-36 is requested. Applicants has inserted the functional terminology required by the Examiner.

It is believed that the objections made by the Examiner

have been overcome and withdrawal of this rejection is requested.

Applicants again traverse the Examiner's restriction requirement and the withdrawal from consideration of claims 33, 39, 44 and 46. It is submitted that the same active ingredient is involved and that these claims should be examined along with all of the other claims in the application.

Applicants submit that the instant claims are now in condition for allowance and a Notice thereof is requested.


Early and favorable action on the part of the Examiner is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, applicant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 02-1445.

Respectfully submitted,

SPRUNG HORN KRAMER & WOODS

By 
Eugene C. Rzuca
Reg No. 31,900

600 Third Avenue
New York, N.Y. 10016
(212) 661-0520